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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,032

04/20/2006

David Clayton Gantner

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EXAMINER

MAZUMDAR, SONYA

ART UNIT

PAPER NUMBER

1745

NOTIFICATION DATE

DELIVERY MODE

03/30/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/577,032	GANTNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SONYA MAZUMDAR	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-24, 26, 28, 30 and 35-38 is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 19, 25, 27, 29, 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/14/2011</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed February 15, 2011 have been fully considered but they are not persuasive.
2. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In this case, it is clear that Colas et al. (EP 0955347) teach applying at least an adhesion promoter on the surface of a silicone gel (paragraph 0028), and it is agreed that Colas et al. fail to teach what type or how much of an adhesion promoters should be used. Applicants argue that Gantner et al. (US 6,512,702) do not teach treating the surface of a film-forming silicone gel on a sheet, but rather teaches applying additive in a film-forming composition. However, upon initial application of the additive, the surface of the film-forming composition is essentially be "treated", which reads on the claim.

If the claim limitation "treating a surface" has a more specific definition than how it is currently being interpreted, in view of carrying out the steps, then the claim should be amended to clarify the invention.

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Thus, the rejection of the claims is maintained.

***Information Disclosure Statement***

3. The information disclosure statement filed February 14, 2011 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. There is neither a copy nor English translation submitted for Japanese document 03-106977.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3, 4, 5, 7, 19, 25, 27, 29, 31, and 34 are rejected under 35 U.S.C. 103(a) as being obvious over Colas et al. in view of Gantner et al.

With respect to claims 19 and 31, Colas et al. teach a method of adhering a silicone gel to a substrate, comprising the steps of (abstract):

casting and curing a layer of a silicone gel on a sheet (paragraph 0028);  
treating the silicone gel with an adhesion promoter (paragraph 0025);  
applying the silicone gel to a carrier (paragraph 0028);  
removing the sheet from the silicone gel (paragraph 0028); and  
applying the silicone gel to a substrate to which the silicone gel is adhered to (abstract; paragraph 0015).

Colas et al. teach applying a silicone gel to a carrier sheet (i.e. first substrate), via a casting (i.e. transfer) method, where an additional adhesive or adhesion promoter (i.e. primer) may be used or even included in the gel, to bond the gel and the carrier sheet, and thus, would have been obvious for one having ordinary skill in the art to treat the surface of the silicone gel when applied to a first substrate (paragraphs 0019, 0025, and 0028); the gel may then be cured following application to the carrier (paragraphs 0030 and 0031). "Where the result accomplished is substantially the same, steps taken

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concurrently or simultaneously are the equivalent of and not patentable over steps taken successively.” (New Wrinkle v. Watson 96 USPQ 436)

Also, Colas et al. do not specifically teach treating silicone gel on a sheet with a specific primer. However, it would have been obvious for one having ordinary skill in the art to do so, as Gantner et al. is cited to teach treating a silicone gel with various agents and/or additives, including titanates and siloxanes, to make a product suitable for its end use. Furthermore, it would have been obvious that the agent is not mixed into the composition initially, since mixing of the component materials in the formulation causes curing at room temperature in the presence of moisture (column 1, lines 6-50; column 3, lines 56-65; column 5, line 47 – column 6, line 42).

With respect to claims 3 and 7, Colas et al. in view of Gantner et al. teach using a carrier or prosthesis of various types of plastic films, such as polyurethanes or silicones (Colas: paragraph 0012).

With respect to claim 4, Colas et al. in view of Gantner et al. teach using a prosthesis (i.e. carrier) of various materials, such as breast prosthesis, incontinence devices, pouches, tubes and other devices (Colas: paragraph 0037; Applicant’s specification: paragraph 0017).

With respect to claim 5, Colas et al. in view of Gantner et al. teach applying a silicon gel layer with a thickness in the range of 0.2 mm to 5 mm (Colas: paragraph 0023).

With respect to claim 25, Colas et al. in view of Gantner et al. teach applying silicone gel with a tack in the range of 50 and 500 g. (Colas: paragraph 0024)

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With respect to claims 27, 29, and 34, Colas et al. in view of Gantner et al. teach applying a primer, diluted in alcohol or hexamethyldisiloxane, by brushing and other various methods (Colas: paragraphs 0031 and 0032; Gantner: column 4, lines 32-38; column 7, lines 33-34).

8. Claims 3, 4, 5, 7, 19, and 25 are rejected under 35 U.S.C. 103(a) as being obvious over Colas et al. in view of Miyoshi et al. (JP 03-106977)

With respect to claim 19, Colas et al. teach a method of adhering a silicone gel to a substrate, comprising the steps of (abstract):

casting and curing a layer of a silicone gel on a sheet (paragraph 0028);  
treating the silicone gel with an adhesion promoter (paragraph 0025);  
applying the silicone gel to a carrier (paragraph 0028);  
removing the sheet from the silicone gel (paragraph 0028); and  
applying the silicone gel to a substrate to which the silicone gel is adhered to (abstract; paragraph 0015).

Colas et al. teach applying a silicone gel to a carrier sheet (i.e. first substrate), via a casting (i.e. transfer) method, where an additional adhesive or adhesion promoter (i.e. primer) may be used or even included in the gel, to bond the gel and the carrier sheet, and thus, would have been obvious for one having ordinary skill in the art to treat the surface of the silicone gel when applied to a first substrate (paragraphs 0019, 0025, and 0028); the gel may then be cured following application to the carrier (paragraphs 0030 and 0031). "Where the result accomplished is substantially the same, steps taken

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concurrently or simultaneously are the equivalent of and not patentable over steps taken successively.” (New Wrinkle v. Watson 96 USPQ 436)

Also, Colas et al. do not specifically teach treating silicone gel on a sheet with a specific primer. However, it would have been obvious for one having ordinary skill in the art to do so, as Miyoshi et al. is cited to teach applying a primer to a silicone gel with various agents and/or additives, including siloxanes (e.g. diorganopolysiloxane and organo-hydrogeno-polysiloxane), where the primer is capable of forming a chemical bond to the silicone gel to be bonded to the support surface and provides good even adhesive strength and excellent performance as buffer from vigorous motions (abstract).

With respect to claims 3 and 7, Colas et al. in view of Gantner et al. teach using a carrier or prosthesis of various types of plastic films, such as polyurethanes or silicones (Colas: paragraph 0012).

With respect to claim 4, Colas et al. in view of Miyoshi et al. teach using a prosthesis (i.e. carrier) of various materials, such as breast prosthesis, incontinence devices, pouches, tubes and other devices (Colas: paragraph 0037; Applicant’s specification: paragraph 0017).

With respect to claim 5, Colas et al. in view of Miyoshi et al. teach applying a silicon gel layer with a thickness in the range of 0.2 mm to 5 mm (Colas: paragraph 0023).

With respect to claim 25, Colas et al. in view of Miyoshi et al. teach applying silicone gel with a tack in the range of 50 and 500 g. (Colas: paragraph 0024)



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9. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colas et al. in view of Gantner et al., as applied to claim 31 above, and further in view of Johnson.

The teachings of claim 31 are as described above.

Although Colas et al. do not specifically teach treating silicone gel on a sheet with a specific primer, it would have been obvious for one having ordinary skill in the art to do so, as Johnson et al. teach the use of tetra-n-butyl titanate and trimethoxymethylsilane as well-known coupling agents (Johnson: claims 1, 6, 7, and 15).

***Allowable Subject Matter***

10. Claims 20-24, 26, 28, 30, and 35-38 are allowed.

Although Colas et al. teach the following steps of adhering a silicone gel to a substrate:

casting and curing a layer of a silicone gel on a sheet (paragraphs 0028);

applying the silicone gel on the sheet to a carrier (paragraph 0038);

removing the sheet from the silicone gel (paragraph 0028); and

applying the silicone gel to a substrate to which the silicone gel is adhered to (abstract; paragraph 0015);

Colas et al. do not specifically teach treating a sheet surface or a surface of a first substrate with a primer selected from titanate materials, zirconate materials, Si--H containing siloxanes and platinum materials.

***Conclusion***

11. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on February 14, 2011 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SONYA MAZUMDAR whose telephone number is (571)272-6019. The examiner can normally be reached on Monday-Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sonya Mazumdar/  
Patent Examiner, Art Unit 1745